UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,753	06/06/2001	Olaf Vancura	112300-3390	8046

29159 7590 10/03/2008

BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER	
PIERCE, WILLIAM M	

ART UNIT	PAPER NUMBER
3711	

NOTIFICATION DATE	DELIVERY MODE
10/03/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No.	Applicant(s)	
	09/875,753	VANCURA, OLAF	
	Examiner	Art Unit	
	William M. Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,8-10,18,19,24,25,30 and 88-122* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,8-10,18,19,24,25,30 and 88-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1, 3, 8-10, 18, 19, 24, 25, 30, 88-117 and 121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention as set forth in the previous office action.

Applicant gives a broad range of pages in the specification (i.e. pg. 19-22, 23-24, pg. 26 and 37) with the assertion that support can be found thereat. Yet no specific instance where the language of the claims is supported in the specification is identified. To account for this lack of being to point to any specific location, applicant relies on the statement that “it is inherent" that such a game "results in the display of one or more outcomes" and that a "second outcome is displayed to the player in the knowledge based game”. In actuality the citations in the specification given by applicant do not discuss any outcomes "displayed to the player" and certainly not a first and second outcome. Further not all wagering games result in a display to a player so the examiner does not agree with applicant's position that such is inherent and does not need to be discussed to be claimed.

Likewise with respect to claim 88, applicant points to pg. 37, lns. 23-30. Yet nowhere in this portion of the specification is a "plurality of first outcomes" discussed.

Likewise pg. 38, lns. 1-25 pointed to by applicant only discuss the play of the game and makes no reference to any display to the player as recited in the claims.

Applicant submits support for claims 8, 10, 117, 120 and 121 at pg. 12, lns. 20-28. He states that the formulas disclosed take into account the wager made by the player and that one can extrapolate that minimum and maximum amounts would change per play of the game. In truth, there is no discussion of a "minimum value and said maximum value are configured to change" as recited by the claims. One should not have to resort to speculation of the specification to find claim support.

As to claims 118, 119 and 122, the example on pg. 11, ln. 5 is considered support for claims drawn to providing a player with a question with a plurality of answers (i.e. multiple choice questions) and awarding a player amounts based upon his selection. The rejection base upon these claims has not been sustained.

2. Claims 1,3, 8-10, 18, 19, 24, 25, 30 and 88-122 are rejected under 35 U.S.C. 103 as being unpatentable over Walker in view of the teachings of Vancura, Martinez, or Kilby as set forth in the previous office action and further in view of Adams 5,848,932;

Applicant's assessment of Walker, Vancura, Marinez, Kilby and Claim 1 are noted but unpersuasive. More specifically in the middle of pg. 21, applicant states that claim 1 recites "two payoffs". However, the claim language in the claims actuality only infer a first and second payout as oppose to a positive recitation. Note claim 1 recites "capable" of resulting in a first payout. Most broadly, any game is capable of resulting in a payout at the discretion of a game operator. This claim Language is in contrast to

language that explicitly sets forth physical steps that must be performed such as a player "receiving" or being "provided" a first payout.

Even if more exact amendments were made to the claims to recite the first and second payoff, such would not overcome the art. These limitations rely on the operation of wagering games of the type having a primary game combined with a secondary only having a single payout that relies on a combination of the outcomes of each game. However, applicant is not the inventor of operating these types of games such that the outcomes of each game are separate. Payouts in such a fashion are a matter of choice to the game designer. Adams 5,848,932 at col. 2, ln. 19 supports this position where payouts from such machines may be separate. In contrast to the Boards previous comments, such were made based upon the prior art on hand. Consideration of what is known to games of a type combining a primary and secondary game and how payments are known to be awarded was not part of their decision.

3. Claims 1,3, 8-10, 18, 19, 24, 25, 30 and 88-122 are rejected under 35 U.S.C. 103 as being unpatentable over Claypole 2,262,642 in view of the teachings of Vancura, Marinez, or Kilby as set forth in the previous office action and further in view of Adams 5,848,932 as set forth above;

Here the issue appears to be the types of games that can be used as a primary game and a secondary game and how payouts are awarded to a player. Here the prior

art fairly teaches using knowledge based games as a secondary game in these types of of games as well as teach that payouts of these game can be independent.

4. The grounds for rejection using Adams as the primary reference has not been sustained in order to reduce issues for appeal. Instead, the examiners interpretation of Adams and his contribution to the art has been applied to the new grounds for rejection above to address the new limitations added to the claims.

Applicant's arguments have been considered as set forth above in the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email, such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711